

**REMARKS**

In the Final Office Action, the Examiner:

objected to claim 20; and

rejected claim 27 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 5,936,548 to Takatsuka ("Takatsuka") in view of U.S. Patent 6,778,069 to Katagiri ("Katagiri"); and

rejected claims 1, 4-6, 9, 11, 13-17, 19-26, and 28 under 35 U.S.C. § 103(a) as unpatentable over Takatsuka in view of Katagiri, further in view of U.S. Patent 7,281,215 to Canfield et al. ("Canfield").<sup>1</sup>

By this amendment, Applicant proposes to amend claim 20, and cancel claims 27 and 28 without prejudice or disclaimer. Claims 1, 4-6, 9, 11, 13-17, and 19-26 would remain pending upon entry of this amendment.

**I. The Objection to Claim 20**

Applicant has amended claim 20 to address the informality raised by the Examiner and to overcome the objection. Accordingly, Applicant respectfully requests the Examiner withdraw the objection to the claims.

**II. The Rejection of Claim 27 Under 35 U.S.C. §103(a)**

Applicant respectfully traverses the rejection of claim 27 under 35 U.S.C. § 103(a) as unpatentable over Takatsuka and Katagiri. Applicant has cancelled claim 27, rendering this rejection moot. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection.

---

<sup>1</sup> As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Final Office Action or certain requirements that may be applicable to the rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

III. **The Rejection of Claims 1, 4-6, 9, 11, 13-17, 19-26, and 28 Under 35 U.S.C. §103(a)**

Applicant respectfully traverses the rejection of claims 1, 4-6, 9, 11, 13-17, 19-26, and 28 under 35 U.S.C. § 103(a) as unpatentable over Takatsuka, Katagiri, and Canfield. Claim 28 has been cancelled, rendering its rejection moot.

Independent claim 1 recites:

providing, at a location on the home screen, a first indicator of the presence of a number of unopened electronic messages received, and an associated value reflecting the number of unopened electronic messages received;

selectively displaying on the visual display a message listing to view portions of electronic messages . . . ;

redisplaying the home screen with the first indicator on the visual display, following display of the message listing . . . ;

altering the first indicator to provide a visually distinguishable non-numerical annunciation that a new unopened electronic message is received, the visually distinguishable non-numerical annunciation distinguishing the new unopened electronic message from the at least one electronic message in the unopened state

(emphases added). Combinations of Takatsuka, Katagiri, and Canfield fail to teach or suggest at least these steps of independent claim 1.

**A. Description of the Present Invention**

Before addressing the prior art references used in the rejection, and the explicit reasons why the prior art fails to teach or suggest the claimed subject matter, a brief overview of the present disclosure and its embodiments will assist in highlighting the differences between the claimed invention and the prior art. As set forth in the specification, the disclosed embodiments assist users who are unable to regularly clean out newly received messages from their inbox due to the sheer volume of messages or

the lack of time or inclination. Applicant's Specification at 4:27-30. Thus, to assist these users who cannot clear all received messages from their inbox, the disclosed embodiments provide a visual indication that new messages have been received since the last time the user looked at the message listing screen. *Id.* at 4:30 to 5:1.

As an example, and without limiting the scope of the claims, FIG. 1 of the specification depicts a mobile device displaying a home screen, where a first indicator 25 depicts the presence of unopened electronic messages, and a numerical value 27 provides a count of the unopened electronic messages. Then, when looking at the screen, a user can know that there are currently two unopened electronic messages.

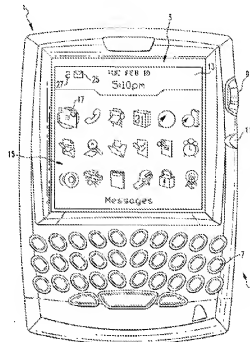


FIG.1

FIG. 2 of the specification depicts the message listing screen accessible from the home screen, where a user is capable of viewing portions of the electronic messages on the device. Moreover, the example depicted in FIG. 2 indicates that there are two unopened electronic messages.

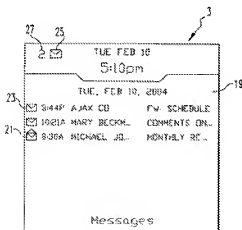


FIG.2

Upon switching the display back to the home screen after not choosing to read the two unopened electronic messages, both the first indicator 25 and the numerical value 27

will still be displayed. At this time, the user receives a new unopened electronic message, and the flowchart of FIG. 4 is followed.

In step 33 of FIG. 4, a new unopened electronic message is received, and the system determines the current screen displayed on the device.

When the user receives net-new messages at 33 and the device is not displaying the message list as those messages arrive, the 'recently checked' flag is set to 'false.' If the user is viewing the message list as these new messages arrive, the system maintains the 'recently checked' flag in the 'true' state. When the 'recently checked' flag is set to 'false,' the unread message count icon 27 is bolded at 35 . . . [and] [a]lternatively, or in addition to bolding the unread message count 27, the mail icon 25 can be bolded.

Applicant's Specification at 5: 20-30. That is, when the home screen is displayed, and following display of the message listing, a new unopened electronic message is received, the system will resolve the "newly checked" flag to "false," and provide an annunciation that a new unopened electronic message is received.

**B. The Prior Art References Fail to Teach or Suggest the Claimed Step of Redisplaying the Home Screen With the First Indicator**

Applicant respectfully traverses the rejection of claims 1, 4-6, 9, 11, 13-17, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over Takatsuka, Katagiri, and Canfield.

Takatsuka discloses a message system where a display "displays the total message number and presence or absence of the non-read message per directory." Takatsuka, col. 5, ll. 15-16. Furthermore, a list display is provided in Takatsuka, where "a portion of the message, receiving date and time, whether or not the message is non-read, and a message sender [is displayed]." Takatsuka, col. 5, ll. 45-47. However, Takatsuka explicitly discloses that a user must **open and read** an unread message to

clear the "non-read" status: "when the user selects the message using the scroll switch . . . and pushes the execution switch 45, the operating section 40 produces a first one of the command signals. Responsive to the first one of the command signals, the control section 20 controls the LCD driver 51 to display the selected message on the display unit 52." Takatsuka, col. 5, ll. 54-60. "Simultaneously, the control section 20 erases the non-read flag of the readout message." Takatsuka, col. 5, ll. 62-64 (emphasis added).

The Examiner appears to rely on Takatsuka as allegedly disclosing the claimed "home screen" as corresponding to, for example, FIG. 5C of Takatsuka, where message directories are indicated and a numerical value is provided as to the number of non-read messages. Final Office Action at 11. Furthermore, the Examiner alleges that FIG. 6 of Takatsuka discloses the claimed "message listing," where portions of messages are displayed, along with date and times for messages, and whether a message is non-read. Id. at 12-13.

The Examiner concedes, however, that Takatsuka "does not disclose the first indicator of the presence of a number of unopened electronic messages received **and** the associated value reflecting the number of unopened electronic messages received are provided at a location on the home screen, as disclosed in the claims." Id. at 13 (emphasis in original). The Examiner instead relies on Katagiri in an effort to allegedly remedy the deficiencies of Takatsuka. Such reliance, however, is improper, as Katagiri fails to cure the deficiencies of Takatsuka.

Katagiri discloses a "radio selective-paging system which is capable of easily recognizing the piece number of unread received messages available for the user among received messages . . . ." Katagiri, col. 1, l. 67 to col. 2, l. 3. In Katagiri, a

controller “store[s] the received message in the message storing unit 3 and at the same time executes the control to **display the received message** on the screen of the display unit 4.” Katagiri, col. 5, ll. 9-12 (emphasis added). The controller in Katagiri further controls an adder unit, and “[w]hen the user applies the already-read instruction operation to the operating unit 6, the adder unit 5 clears the counted value to zero, and then adds the piece number of the received messages after the already-read instruction operation for every attribute.” Katagiri, col. 5, ll. 16-20. Thus, Katagiri, similar to Takatsuka, discloses that a user performs a reading operation on the unread messages.

Furthermore, Katagiri discloses that “a mark ‘.star.’ indicating that the received message has not been read yet is displayed on the third line of the screen . . . [and] a numeral ‘1’ which is the piece number of the unread received message[] counted by the adder unit 5 is displayed on the fourth line of the screen.” Katagiri, col. 5, ll. 46-51. “[W]hen the user applies the already-read instruction operation, which indicates that the received message being displayed on the screen has been read by the user . . . the mark ‘.star.’ displayed on the third line to indicate that the receive[d] message has not been read yet is cleared.” Katagiri, col. 5, ll. 57-63. That is, once the user reads an unread message, the star indicator is cleared, as exemplified in FIG. 2C and FIG. 2D. However, the combination of Takatsuka and Katagiri still does not teach or suggest “redisplaying the home screen with the first indicator on the visual display, following display of the message listing, and while the at least one electronic message is in the unopened state,” as recited in claim 1.

Specifically, Katagiri explains  
with reference to FIG. 2C, reproduced  
at right, that ten messages are  
received, and the user has not read

FIG. 2C

10:20
A
☆
10
~ VACANT SEAT INFORMATION ~ (AT 10:10)
THEATER 001: 11:00 ~ △
THEATER 002: 11:00 ~ ○

these messages, so the star indicator is provided. Thus, the Examiner appears to  
allege that the presence of the star indicator corresponds to the claimed “first indicator,”  
and the numerical value of 10 corresponds to the claimed “associated value reflecting  
the number of unopened electronic messages received,” as recited in independent

FIG. 2D

10:20
A
9
~ VACANT SEAT INFORMATION ~ (AT 10:10)
THEATER 001: 11:00 ~ △
THEATER 002: 11:00 ~ ○

claim 1. However, Katagiri goes on  
to explain with reference to FIG. 2D,  
reproduced at left, that a user inputs  
an instruction **to read** one of the 10

messages, and based on this action, the **star indicator is cleared and removed** “since  
the user has input the already-read instruction operation, which indicates that the  
received message of “Vacant Seat Situation at a time 10:10 in the Theater 001 and the  
Theater 002” . . . has been read by the user . . . [and] the piece number of the unread  
received messages displayed on the fourth line is changed from “10” to “9.” Katagiri,  
col. 6, ll. 8-15.

Therefore, at this point, Katagiri removes the star indicator and **only displays a  
numerical value** (e.g., “9”) representing a number of unread received messages, even  
though additional messages are in an unread state. Indeed, the Examiner concedes  
this fact, stating that “[w]hen, in Katagiri, one of the new non-read message[s] is opened  
and read, then the indicator for new non-read messages **is removed** and the numeric

value indicating the number of new non-read messages is decremented by one.” Final Office Action at 4 (emphasis added). If Katagiri removes the indicator, then the combination of Takatsuka and Katagiri cannot disclose “redisplaying the home screen **with the first indicator** on the visual display, following display of the message listing, and while the at least one electronic message is in the unopened state,” as recited in independent claim 1 (emphasis added).

Specifically, claim 1 requires that the “first indicator” be displayed upon redisplay of the home screen, and while the at least one electronic message is in the unopened state. As the Examiner has equated the claimed “first indicator” with the star indicator of Katagiri, then the star indicator must be maintained and displayed on the home screen. However, as noted by Katagiri, the star indicator “is cleared since the user has input the already-read instruction operation,” and the star indicator is therefore removed based on the user reading a message. See Katagiri, col. 6, ll. 7-9. Furthermore, as shown above in FIG. 2D of Katagiri, only the numerical value is displayed, which the Examiner does not equate to the claimed “first indicator.”

Furthermore, as shown in FIG. 2E of Katagiri, when new unread messages are received after clearing the star indicator, Katagiri will simply redisplay the star indicator and will display the number of only newly received unread messages. As a result, Katagiri provides no ability to distinguish between electronic messages still in the unopened state (i.e., the previous nine unopened messages), and newly received unread electronic messages (i.e., the new two messages). The Examiner alleges that the claims “in no way require[] that NONE of the non-opened messages be un-opened. In Katagiri, some non-read, i.e. non-opened, messages may still remain non-read and



non-opened while the indicator for new non-read and non-opened messages is removed.” Final Office Action at 5. But in this instance, the Examiner admits that Katagiri will remove the indicator, and therefore any redisplay of a home screen would not include the star indicator, which the Examiner has equated to the claimed “first indicator.”

Therefore, the combination of Takatsuka and Katagiri cannot disclose “redisplaying the home screen **with the first indicator** on the visual display, following display of the message listing, and while at least one electronic message is still in an unopened state[,] and altering the first indicator to provide a visually distinguishable non-numerical annunciation that a new unopened electronic message is received, the visually distinguishable non-numerical annunciation distinguishing the new unopened electronic message from the at least one electronic message in the unopened state,” as recited in claim 1 (emphasis added).

**C. The Prior Art References Fail to Teach or Suggest the Claimed Step of Altering the First Indicator to Provide a Visually Distinguishable Non-Numerical Annunciation**

Independent claim 1 further recites that the first indicator must be altered “to provide a visually distinguishable non-numerical annunciation that a new unopened electronic message is received, the visually distinguishable non-numerical annunciation distinguishing the new unopened electronic message from the at least one electronic message in the unopened state.” As noted above, the combination of Takatsuka and Katagiri does not teach or suggest that the first indicator is displayed on the home screen following display of the message listing and while the at least one electronic message is in the unopened state. Moreover, since the first indicator is not displayed

on the home screen following display of the message listing, there can also be no alteration of this first indicator as required by independent claim 1.

Indeed, the Examiner admits that "Takatsuka and Katagiri do not disclose altering said the first indicator to provide a visually distinguishable non-numerical annunciation distinguishing the new unopened electronic message from the at least one electronic message in the unopened state, as disclosed in the claims." Final Office Action at 15. The Office instead relies on Canfield to remedy the deficiencies of Takatsuka and Katagiri. Such reliance, however, is improper, as Canfield fails to cure the deficiencies of Takatsuka and Katagiri.

Canfield is directed to an instant messaging user interface "that enables perception and selection of instant messages for an instant messaging user, and a status indicator that provides a perceivable indication to the user of statistics regarding concurrent instant messaging sessions." Canfield, col. 1, ll. 40-44. In Canfield, the interface provides an identifier for IM sessions, where "a user is able to read or otherwise recognize the identifier no matter how many other IM sessions are pending. An interface table also includes a status identifier to indicate whether a new IM message is waiting to be viewed for that session." To provide the user with information regarding a new IM message, a tabbed IM UI provides, "an indicator such as a blinking interface tab or area on an interface tab may be provided for a received IM message that has not been viewed. When the user views the received IM, the indicator may change to a solid IM interface tab or area on an interface tab." Canfield, col. 3, ll. 19-25.

The Examiner presumably equates the ability of Canfield to display a blinking interface tab with the claimed alteration of the first indicator. However, the combination

proposed by the Examiner ignores the context of the independent claim 1, which requires that the alteration be **performed on the first indicator**, which is an indicator “of the presence of a number of a number of unopened electronic messages received” and which is provided “at a location on the home screen.” Canfield discloses that the interface tab can be blinked to indicate the presence of a new IM message, but the **interface tab itself is not an indicator** of the presence of a number of unopened electronic messages. Therefore, the blinking of the interface tab cannot constitute “alternating the first indicator” because the interface tab cannot equate to the claimed first indicator.

Moreover, at this point, what the Examiner considers as the “first indicator” has changed from the star indicator, as alleged during the combination of Takatsuka and Katagiri, into an interface tab or area on an tabbed IM UI, based on the combination with Canfield. It appears that the Examiner is attempting to combine the Canfield with Takatsuka and Katagiri in a piecemeal fashion using Applicant's claims as a blueprint, rather than considering the references as a whole. See, e.g., MPEP at § 2141.02(VI).

Such piecemeal citation to individual pieces of prior art references ignores the references as a whole, and ignores the underlying teachings of the references, as one of ordinary skill in the art would not have any requirement for a tabbed IM interface in the systems of Takatsuka and Katagiri, which both already provide indicators in the form of a numerical value, or a star indicator. Moreover, if the Examiner alleges that the star indicator of Katagiri equates to the claimed first indicator, then an addition of a blinking interface tab would still not result in any alteration to the star indicator of Katagiri, and the proposed combination would not result in the claimed “altering the first indicator to

provide a visually distinguishable non-numerical annunciation that a new unopened electronic message is received,” as recited in independent claim 1.

**D. The Final Office Action Fails to Provide Any Reasons for Combining Canfield with Takatsuka and Katagiri**

Finally, Applicant traverses the rejection of the claims because the Final Office Action fails to properly establish a *prima facie* case of obviousness by providing any reason as to why one of ordinary skill in the art would seek to combine Canfield with Takatsuka and Katagiri. The Examiner alleges that the combination of Canfield with Takatsuka and Katagiri is proper and that one would have been motivated to combine the references to arrive at the claimed invention “because the Supreme Court in *KSR International Co. v. Teleflex Inc.* identified applying a known technique to a known device (method, or product) ready for improvement to yield predictable results as a rationale to support a conclusion of obviousness which is consistent with the proper ‘functional approach’ to the determination of obviousness laid down in *Graham*.” Final Office Action at 15-16. This provided “reasoning” for the combination, however, is entirely devoid of any factual basis or reasoning related to the present invention or the claims. Furthermore, simply indicating disparate references as having claimed elements does not meet the burden of establishing a *prima facie* case of obviousness.

As stated by the Federal Circuit, “virtually all [inventions] are combinations of old elements.” See e.g., In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted). The Federal Circuit has explained that an Examiner may find every element of a claimed invention in the prior art, but mere identification is not sufficient to negate patentability. Id. The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same

problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *Id.* Indeed, the Supreme Court confirmed that there must be a reason to combine, and this analysis should be made explicit. KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740-1741 (2007).

Here, the Examiner's alleged motivation to combine Canfield with Takatsuka and Katagiri ("applying a known technique to a known device (method, or product) ready for improvement to yield predictable results") is entirely generic and devoid of any factual reasoning, and therefore fails to provide any reasons that a skilled artisan would combine the references in the manner claimed. If the Examiner's alleged motivation were true, no patents would ever issue, as any device could theoretically be considered a "known device ready for improvement." The KSR decision does not stand for the presumption that an Examiner can simply combine references without regard to any factual aspects of the underlying references. The U.S. Patent & Trademark Office has emphasized in its *2010 Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v. Teleflex* that examiners must continue to provide a **reasoned explanation** as to why the invention as claimed would have been obvious to a person of ordinary skill in the art at the time of the invention. KSR, 127 S. Ct. at 1741; 75 Fed. Reg. 53643-60 at 53645, second column. Here, the Examiner's alleged motivation for the combination of the references provides zero reasoning as to why one of ordinary skill in the art would look to combine Canfield with Takatsuka and Katagiri, and therefore fails to establish a *prima facie* case of obviousness with respect to the claims. As such, the Final Office Action is improper and must be withdrawn.

### **CONCLUSION**

In view of the above differences between the subject matter of claim 1 and the disclosure of the cited references, a *prima facie* case of obviousness has not been established with respect to amended independent claim 1. Accordingly, the rejection of claim 1 should be withdrawn and claim 1 should be allowed.

Independent claims 4, 11, 19, and 20, though of different scope from claim 1, recite subject matter similar to that discussed above for claim 1. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 4, 11, 19, and 20 for at least similar reasons as claim 1. Thus, claims 4, 11, 19, and 20 should be allowed.

Furthermore, a *prima facie* case of obviousness has not been established with respect to the dependent claims 5, 6, 9, 13-17, and 21-26 at least due to their dependence from one of independent claims 1, 4, 11, 19, and 20, as well as for their own distinguishable features over the cited prior art.

Accordingly, Applicant respectfully requests the withdrawal of the rejection of claims 1, 4-6, 9, 11, 13-17, 19-26, and 28 under 35 U.S.C. § 103(a).

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Office, placing the claims in condition for allowance. It is respectfully submitted that the entering of the Amendment would allow Applicant to reply to the final rejections and place the application in condition for allowance. Furthermore, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the Office dispute the patentability of the pending claims

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, the Examiner is invited to call the undersigned at (202) 408-4268.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: April 11, 2012

By: /Trenton J. Roche/  
Trenton J. Roche  
Reg. No. 61,164  
(202) 408-4268